

**Pre-Appeal Brief Request for Review**

VIA E-FILE

PATENT APPLICATION  
Docket No. 14531.86

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Peter J. Potrebic	)	
		)	
Serial No.:	09/781,110	)	Art Unit
		)	2623
Filed:	February 9, 2001	)	
		)	
For:	SYSTEMS AND METHODS FOR RECORDING FRAGMENTED PROGRAMS	)	
		)	
Confirmation No.:	2976	)	
		)	
Customer No.:	047973	)	
		)	
Examiner:	Annan Q. Shang	)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

VIA E-FILE **Appeal**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A succinct, concise and focused set of arguments for which the panel review is being requested begins on page 2.

## REMARKS

Reconsideration of the application by a panel of examiners is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified are presented by way of example to illustrate some of the clear errors and omissions needed for a *prima facie* rejection. In addition, Applicants request that the Panel carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references is consistent with the Panel's understanding.

### I. CLAIM REJECTIONS

#### A. **Rejections Under 35 U.S.C. §103**

The Patent Office rejects claims 1-5, 9-23, 25, 26 and 28-35 under 35 U.S.C. § 103(a) as being unpatentable over *Wood* (2003/0044165) in view of *Knudson* (2005/0273819), and further in view of *Abbott* (5,973,679). Claim 32 was rejected as claim 1, and further in view of *Yi* (6,094,427). Applicant respectfully traverses this rejection as based on failure to provide an essential element for a proper *prima facie* case of obviousness.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what the prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142.

It is well recognized that in order to have a valid case of *prima facie* obviousness, all claim limitations must be taught or suggested (*see* M.P.E.P. § 2143). Each of the currently pending independent claims 1, 21 and 26 recited, among other things: "*electronic program guide data used to identify the one or more fragmented programs includes a unique identifier that is assigned to each fragment in a group of fragmented programs, which are identified by the network as being related,*

and such that *each fragment* corresponding to the fragmented program grouping *have a same unique identifier and that is distinguished and independent from a program title*.”

In direct contrast, *Wood* discloses a method for recording a single episode of a series by clicking once on the *program title*, and recording each episode of the series by clicking twice on the *program title*. ¶¶ 50-51. At most, this disclosure in *Woods* suggests that a fragment (e.g., episode) of a fragmented program (e.g., series) is selected and identified by using the program title rather than a unique identifier shared by all fragments corresponding to the fragmented program and which is distinguished and independent from a program title.

To compensate for the apparent deficiency in *Woods* to teach or suggest that each fragmented program grouping has ‘a same unique identifier and that is distinguished and independent from a program title’, the Examiner relies on inherency, by stating that a “Show inherently includes a unique identifier that is distinguished from a program title, which identifies the Show(s) and enables a specific Show(s) to be search and retrieved” from various databases. Office Action, p. 3. Applicants respectfully traverse.

To rely on a theory of inherency, the Patent Office “must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112(IV). This is required inasmuch as the “mere fact that a certain thing may result from a given set of circumstances is not sufficient” to support an assertion of inherency. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); M.P.E.P. § 2112(IV).

The Patent Office has, however, failed to provide a sufficient basis in fact or technical reasoning to support the assertion that it is necessary that a unique identifier that is independent from a program title be assigned to each fragment of a fragmented program. Instead, the Office Action merely concludes that a unique identifier is inherent as it enables a specific show to be searched and retrieved. Applicants note, however, as previously discussed with the Examiner, that other means such as a series name, title, etc. can each be used within a database to perform the search or retrieval operations. Accordingly, it is clear error to suggest that it would be necessary, and therefore inherent, for a unique identifier that is distinguished and independent from a program title to be provided to identify related programs.

Notably, the supplied theory of inherency, even if true, *arguendo*, still fails to suggest or teach the claimed element, as recited in combination with the other claim elements. In particular, the recited theory asserts that a “Show” includes a unique identifier that is distinguished from a program title. In contrast, the claimed invention recites that the unique identifier is provided within the

"electronic program guide data" rather than a show, or fragment. Accordingly, the Patent Office has failed to even assert that the prior art teaches a unique identifier included in electronic program guide data, as claimed.

Applicants also submit that the Patent Office has failed to establish a *prima facie* case of obviousness with regard to independent claims 1, 21 and 26 (and the claims depending therefrom) inasmuch as the claims recite that *the unique identifier* of the electronic program guide data is *common to each fragment* within a corresponding grouping of programs which are identified by the network as being related and such that each fragment corresponding to the fragmented program grouping has the same unique identifier which is distinguished and independent from a program title. In fact, the Patent Office has acknowledged that such a teaching is not found within *Wood* and *Knudson*, even when combined. Office Action, p. 5. To this end, *Abbott* is relied upon.

The *Abbott* reference, however, is no more instructive on this point. Instead, *Abbott* discloses a system in which a media stream is indexed in such a way that a recorded series is assigned a unique series ID when it is stored. See Office Action, p. 5. In *Abbott*, a system is disclosed for allowing storage and delivery of a program that is indexed and synchronized to allow customized delivery to a viewer. To do so, content of a program is broken into one or more "atoms," while delivery is of the content is provided to the viewer by via "segments," "series," and "groups." Col. 2, ll. 1-11. The segments (i.e. portions of atom fragments) are arranged sequentially into a "series," while one or more "series" are arranged into "groups" for parallel delivery to the user. Col. 7, ll. 12-15, 21-24. For example, a movie may be provided to a user by using three simultaneous series, one for each of audio, video and close-captioning. Col. 5, ll. 63-65; Col. 7, ll. 21-22, 52-61. Accordingly, a "series" as defined in *Abbott* is a subset of a single broadcast program, rather than a type of television series as understood in the television industry.

Notably, Applicants' specification expressly defines the term "fragmented program" as referring to a program that is divided into a series of airings or a plurality of programs that are related in some way to each other. A fragment is, therefore, defined as one or more of these airings of the fragmented program. Specification, p. 9. In contrast, each "series" and "grouping" in *Abbott* appears to be a cohesive and interconnected set of segments and data presented as a subset of one, continuous broadcast. Accordingly, *Abbott* also fails to describe where "each fragment is broadcast to the entertainment system as a separate and independent program from other related fragments," as claimed.

Moreover, *Abbott* describes that each atom, segment, series and group is given its own, unique ID when it is stored. Col. 6, ll. 12-14, 48-49; Col. 7, ll. 16-17, 28-29. This allows, for

example, a system in which a viewer can interactively control a viewed program to playback a portion of a program, skip ahead in a program, or to implement slow-motion, still, pause, etc. Col. 12, ln. 65 to Col. 13, ln. 21. This may be done, for example, by allowing the viewer to specify the time to which the user would like to skip. Col. 13, ll. 11-14.

In contrast, however, the independent claims recite where each fragment in a group of fragments is assigned a common unique identifier, and such that fragments of a fragmented program have the same unique identifier independent of a program title. *Abbott* teaches that each object has its own unique ID to allow for special play modes, but fails to teach or even suggest that each fragment in a fragmented program includes the *same unique identifier*, much less that the identifier is within electronic program guide data used to identify one or more fragmented programs, as claimed.

Accordingly, the rejections set forth by the Patent Office for obviousness are improper because the Patent Office has not made out a *prima facie* case of obviousness and provided references teaching or suggesting all of the claim limitations. In that regard, at this point there is no clear factual basis set forth by the Patent Office. Thus, Applicants respectfully request the Panel consider whether the Patent Office's burden has been met to supply a *prima facie* case of obviousness with respect to claims 1-5, 9-23, 25, 26 and 28-35, prior to Applicants' submission of the Appeal Brief.

### CONCLUSION

In view of the foregoing, Applicants believe the rejections are based on clear error and the claims are in allowable form. In the event that the Examiner, or the panel, finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 1<sup>st</sup> day of June, 2006.

Respectfully submitted,



JENS C. JENKINS  
Registration No. 44,803  
Attorney for Applicant  
Customer No. 47973  
Telephone: (801) 533-9800